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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,267	01/02/2002	Tom Howard	10011529-1	6181

7590 08/10/2005  
HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

SZYMANSKI, THOMAS M

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/037,267

**Applicant(s)**

HOWARD ET AL.

**Examiner**

Thomas Szymanski

**Art Unit**

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 1/02/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02/04/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-20 have been examined.

#### ***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
3. The applicant is requested to review the specification and update the status of all co-pending applications made mention of, replacing attorney docket numbers with current U.S. application or patent numbers when appropriate. References to U.S. applications or patents should make it clear as to what the number refers (e.g. U.S. Patent No. #), instead of listing only the number.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1-2, 4-7, and 9-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hasebe U.S. Patent No. 5,987,609.

6. Regarding Claim 1: A device for preventing unauthorized use (Col 5 lines 56-67 Col 6 lines 1-67)

Processor (Col 4 lines 47-48)

Wireless communication subsystem (Col 4 lines 37-46)

Security protocol operable to prevent execution of software upon receiving a message (Col 3 lines 21-37, Col 6 lines 44-55 Fig 6) As provided for by Hasebe the security process as implemented allows for prevention of the execution of software by only displaying that which has been selected by the user in fig 6 and not the execution of any phone functions as such preventing execution of software by the implemented security protocol.

7. Regarding Claim 2: Non-volatile memory for storing information to indicate software is not permitted for execution (Col 6 lines 60-65)

8. Regarding Claim 4: Preventing access to user data (Fig 6, Col 6 lines 32-59)

Hasebe describes several forms of preventing access to the data, one being locking the system and another being deletion of files upon recognition of the device being compromised.

9. Regarding Claim 5: Protocol causes application to exit if message received while running (Col 5 lines 65-67, Col 6 lines 1-7, 23-67) The functionality of the system requires that the program exit while running as that is the manner in which it must

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operate. Since the system must be on to receive messages in order to function it must then exit the running normal state in order to implement the selected security level.

11. Regarding Claim 6: A display for presenting an unauthorized message (Fig 3 part 17, Col 6 lines 49-55)

12. Regarding Claim 7: Implementation within an operating system (Fig 3, Col 5 lines 56-67 Col 6 lines 1-67) The system must have an operating system as it would otherwise not function. The security protocol must be implemented within the operating system as it is part of the system and wouldn't have functionality independently. As it can be seen from Fig 3 part 12 the system software is contained together as separate modules reliant upon the operating system.

13. Claims 9-15 and 16-20 are a method and system implementation of claims 1-2, and 4-7; therefore, claims 9-20 are rejected on the same grounds.

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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15. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hasebe U.S. Patent No. 5,987,609 as applied to claim 2 above, and further in view of Barrus et al U.S. Publication No. 2001/0045884.

16. Hasebe has provided a system that provides for storing information in non-volatile memory, but he does not explicitly state that the memory is Flash Memory.

17. Barrus et al provides for a system within which a security protocol is implemented with Flash memory (pg. 2 paragraph 0016).

18. It is desirable within a security system to be able to implement proactive steps for purposes of improved security, it is especially advantageous to be able to obtain any information as to the possession and or location of such a device when it is in an unauthorized state.

19. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the system of Barrus et al with that of Hasebe. The combination of these two systems forms a better system with improved security measures and thus greater data integrity.

20. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hasebe U.S. Patent No. 5,987,609 as applied to claim 1 above, and further in view of Davis et al United States Patent Application Publication No. 2002/0004905.

21. Hasebe has provided a system that provides for securing the device while running but fails to teach checking the integrity of the system prior to booting for identification of a tampered system.

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22. Davis et al provides for a system within which the integrity of the system is checked for security purposes prior to booting the system (Davis et al paragraph 0018)

23. Within any system containing data or sensitive access to a system strong security functionality is always desirable to prevent unauthorized acquisition and use of the device and its contents. (Davis et al pg 1 paragraphs 0004-0009)

24. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the system of Davis et al with that of Hasebe for the improved security functionality that is obtained from preventing access to the system while it is not connected to the network by the implementation of the integrity checking of the firmware within the system. The Davis et al system when implemented with Hasebe would check the firmware which within the implementation of Hasebe et al consists of all that is necessary for the operation of the system which is all of that which is contained on ROM and RAM (Hasebe Fig 3, 12 and 13)

25. Claims 9-15 and 16-20 are a method and system implementation of claims 3 and 8; therefore, claims 9-20 are rejected on the same grounds.

### ***Conclusion***

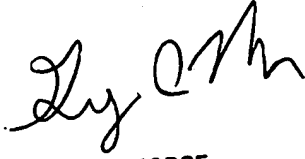
26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of art disclosed by the references cited and the objections made. Applicant must show how the amendments avoid such references and objections. See 37 CFR 1.111(c).

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27. Inquiries concerning this communication or earlier communications from the examiner should be directed to Thomas M. Szymanski who can be reached at (571) 272-8574. The examiner's normal working schedule is between the hours 8:00am – 4:30pm (EST), Monday – Friday.

28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached at (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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